



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/806,436

03/23/2004

Takahiro Kaneko

8728303

1670

21254

7590

04/10/2009

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC

8321 OLD COURTHOUSE ROAD

SUITE 200

VIENNA, VA 22182-3817

EXAMINER

GELIN, JEAN ALLAND

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

04/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. This is in response to the Applicant's arguments and amendments filed on February 03, 2009 in which claims 1, 17-20, and 23-27 has been amended. Claims 1-4, 7-14, and 16-28 are currently pending.

Response to Arguments

2. Applicant's arguments filed 02/03/09 have been fully considered but they are not persuasive

As per claim 1, the Applicant argues that by detecting reception field levels only when a threshold is reached, battery consumption will be decreased and switchover will be faster due to immediate detection of the threshold. However, the Examiner maintains that the preceding limitation is nowhere to be found in the claim. Therefore, Applicant's argument is not persuasive, and the rejection recited above is maintained.

The Applicant further argues that the claimed invention may switch from one wireless unit to another wireless unit on the basis of the reception field that is currently selected. None of the applied references discloses or suggests the preceding features as described in the independent claims. However, the Examiner disagrees with the preceding arguments. The core of the invention is to select the communication system on the basis of the reception field level (i.e., signal quality/strength). Kiyomoto teaches selecting a system for communication based upon priority and reception strength. A threshold value is set to make the comparison and determine the signal quality level to switch from one system to another system (col. 7, line 7 to col. 8, line 23). Kiyomoto

Art Unit: 2617

further teaches when the terminal is powered on, it selects the system having prior order, if the selected system is deteriorated, it compares signals received from other system with a threshold and selects the system having better quality signal (col. 5, line 17 to col. 6, line 55). Therefore, the system of Kiyomoto reads on first system is selected, second system has priority, and communication with the second system is possible. But a notification that the second system has priority is not present in Kiyomoto. Arimitsu discloses that the mobile terminal notifies original network system of data about other network systems that provide the signal reception level being higher than a specified level ([0005]) the mobile terminal decides and notifies system's selection ([0045] and [0049]). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Arimitsu within the system of Kiyomoto in order that the mobile terminal can decide when to switch from the present network to a new network system based on strength of signal reception levels provided by other networks. (See KSR for suggestion to combine).

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should

As per claims 8 and 15, the Applicant argues that Williams disclose displaying the system the terminal is currently active but does not overcome the deficiency of Kiyomoto and Arimitsu because there is no suggestion to combine the teaching of Williams with Kiyomoto in view of Arimitsu. However, the Examiner disagrees with

preceding assertion. Williams teaches an interface that controls light emitting diodes which are used to indicate to the user which system the PCC is currently receiving; for example a system identifier may appear in the display of the PCC 101 to indicate the user which system he is in (col. 4, lines 17-39, col. 11, lines 33-44, and col. 12, lines 31-42). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Williams within the system Kiyomoto with Arimitsu in order that the indication enables the user to determine which system he is in and decide whether he wishes to complete a radiotelephone in the indicated system.

(See KSR for suggestion to combine)

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should

The Applicant further argues that the Examiner makes no attempt to point out specific lines and cols. location in the prior arts for the rejections claims 20-22. However, the Examiner maintains that the claims are properly rejected as recited above. Claim 20 is the method claim of claim 1. Claim 20 merely teaches signal strength of the first system is dropped below a prescribed threshold, a second system is detected, and the second system is selected for communication. The Examiner does not see any difference between claim 1 and 20 in terms of claimed invention. Therefore, claims 20-22 are rejected for the same reasons recited above.

As per claim 23, the Applicant argues that the Examiner attempts to rely upon selection of the system in accordance with a priority listing, Applicant respectfully submits that such automatic selection fails to satisfy the plain meaning of the claim language of this claim, since the "prescribed operation" is an event that is involved in the automatic selection and involves a user interaction with the terminal. The rejection improperly attempts to define the automatic selection by the CPU as being the "prescribed operation." However, the Examiner disagrees with the preceding arguments. the Wording of claim 23 may different with other independent claims, But the claim limitation is nothing more than: detecting a dropped of signal strength in the first communication system, and detecting a second communication system having a better signal strength and selecting the second communication system for communication (read on cols. 7-8 of Kiyomoto). The automatic selection is performed upon triggering by event. The threshold value is set for the terminal to perform certain operation when the terminal exceeds threshold value. Therefore, the rejections of claims 23-28 are maintained for the same reasons recited in the previous office action. Therefore, claims 23-28 are also clearly patentable over Kiyomoto.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN A. GELIN whose telephone number is (571)272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

Art Unit: 2617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jean A Gelin/
Primary Examiner, Art Unit 2617